

REMARKS/ARGUMENTS

In the Claims:

Allowable Subject Matter

Applicant appreciates the Examiner's consideration of Applicant's previously filed remarks and arguments, and the subsequent indication of allowance of claims 75-77, 80, 85, 88, 89, 92-94, 96, 99, 102, 103, 106, 107, 110, 111, 114, 115, 118-121, 124-133, 135-142, 144-151, 153-160 and 162-165.

Rejection of Claims 78, 134, 143, 152 and 161 Under 35 U.S.C. § 112

The Examiner rejected claims 78, 134, 143, 152 and 161 under 35 U.S.C. § 112, first paragraph, as containing subject matter not adequately described in the specification. Specifically, the Examiner believes the recited range of length (i.e., 10-25 inches) appearing in each of the rejected claims is not supported by the specification. Applicant respectfully asserts that there is support for the rejected subject matter and, as such, the rejection is traversed.

Applicant agrees with the Examiner that the length range appearing in column 7, lines 5-7 of US 5,830,237 is specifically directed to an unclaimed open-ended sleeve embodiment. However, in col. 13, lines 46-49 of the '237 patent, it is stated that "The invention articles are designed primarily for the human wearer, and thus are sized appropriately. Diameters typically vary from 1-8 inches (unstretched) and *overall lengths typically vary from 1-30 inches (unstretched).*" (emphasis added) Therefore, the 10-25 inch length recited in each of rejected claims 78, 134, 143, 152 and 161 is within this stated range and is, consequently, supported by the specification. Applicant simply elected to claim a narrower range

of lengths – a range that is more common in actual practice with respect to the claimed subject matter.

As Applicant has identified in the specification support for the subject matter of the rejected claims, Applicant respectfully requests that the Examiner's 35 U.S.C. § 112 rejection of claims 78, 134, 143, 152 and 161 be withdrawn.

NOTICE OF CONCURRENT PROCEEDINGS

Upon review of the present application file history, it was discovered that information regarding concurrent proceedings related to subject matter similar to that of the present application has not yet been brought to the Examiner's attention. As such, listed below are descriptions of several concurrent proceedings and certain other information that the Examiner may wish to consider upon further examination of the present application.

Reexamination Proceedings

The present application is a continuation of application serial no. 08/611,306, which issued as US Patent No. 5,830,237. The '237 patent is currently involved in an ex parte reexamination proceeding (serial no. 90/008,277) before the USPTO. The Order granting the request for reexamination was mailed on 12/13/2006. The reexamination involves claims 1, 2, 4, 6-8, 12-16 and 18-23 of the '237 patent. A copy of the Order is attached to this response for the Examiner's convenience.

Applicant is also the named inventor of US Patent No. 6,964,688, which issued from application serial no. 09/418,505 on November 15, 2005. The '688

patent is currently involved in an ex parte reexamination proceeding (serial no. 90/008,271) before the USPTO. The Order granting the request for reexamination was mailed on 12/01/2006. The reexamination involves claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69 of the '688 patent. A second request for reexamination (serial no. 90/008,578) covering additional claims of the '688 patent was filed on April 04, 2007. However, a Notice of Failure to Comply with Ex Parte Reexamination Request Filing Requirements was mailed on April 18, 2007 with respect to this second request. As such, the above-listed claims are the only claims of the '688 patent currently subject to reexamination. A copy of the Order granting the first request for reexamination, as well as a copy of the above-referenced Notice of Failure to Comply are attached to this response for the Examiner's convenience.

Litigation Proceedings

U.S. Patent No. 5,830,237 is currently involved in the following patent infringement litigation:

- (1) The Ohio Willow Wood Company v. ALPS South Corporation, Case No. 2:04-cv-01223, filed on 12/27/04 in the United States District Court for the Southern District of Ohio, Eastern Division. This case was stayed on 11/22/06 pending the outcome of the above-referenced reexamination proceeding.
- (2) The Ohio Willow Wood Company v. DAW Industries, Inc., Case No. 2:04-cv-01222, filed on 12/27/04 in the United States District Court for the

Southern District of Ohio, Eastern Division. This case was consolidated with Case No. 2:05-cv-01038 on 08/18/06. Case No. 2:05-cv-01038 was filed on 11/16/05 in the same court, and is a patent infringement case against DAW relating to U.S. Patent No. 6,964,688 assigned to Ohio Willow Wood. The consolidated cases were stayed on 11/22/06 pending the outcome of the above-referenced reexamination proceeding.

- (3) Thermo-Ply, Inc. v. The Ohio Willow Wood Company, Case No. 8:05-cv-00779, filed on 04/21/2005 in the United States District Court for the Middle District of Florida, Tampa Division. This case is currently pending.

U.S. Patent No. 6,964,688 is currently involved in the following patent infringement litigation:

- (1) The Ohio Willow Wood Company v. ALPS South Corporation, Case No. 2:05-cv-01039, filed on 11/16/05 in the United States District Court for the Southern District of Ohio, Eastern Division. This case was stayed on 02/01/07 pending the outcome of the above-referenced reexamination proceeding.
- (2) The Ohio Willow Wood Company v. DAW Industries, Inc., Case No. 2:05-cv-01038, filed on 11/16/05 in the United States District Court for the Southern District of Ohio, Eastern Division. This case was consolidated with Case No. 2:04-cv-01222 on 08/18/06. Case No. 2:04-cv-01222 was filed on 12/27/04 in the same court, and is a patent infringement case against DAW relating to U.S. Patent No. 5,830,237 assigned to Ohio Willow

Wood. The consolidated cases were stayed on 11/22/06 pending the outcome of the above-referenced reexamination proceeding.

European Opposition Proceedings

The present application is related to European patent EP 0762857 B1, granted on November 09, 2005, in that the European patent claims priority to US Patent No. 5,830,237, of which the present application is a continuation. EP 0762857 B1 is currently the subject of an Opposition proceeding before the European Patent Office. Applicant notes, however, that all but one of the references cited by the opponents in said Opposition proceeding were previously provided to the Examiner. The only new reference, an undated and non-translated advertisement for what appears to be an Otto Bock "Derma Seal" product, has been provided with the Supplemental Information Disclosure Statement discussed below.

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

In conjunction with this Response, Applicant is also filing a Supplemental Information Disclosure Statement. The listed references include those references cited by the requestor in the above-listed reexamination proceedings of the '237 and '688 patents, two patent documents that were discovered during the above-referenced litigation and appear to be, at best, tangentially related to the claimed subject matter, and the above-referenced Otto Bock advertisement submitted in the EP Opposition proceeding. Applicant in no way admits or believes that any of the references listed on the Supplemental IDS affect the patentability of the

present application. Nonetheless, Applicant is submitting the Supplemental IDS in the interest of full disclosure.

With respect to the references associated with the reexamination proceedings, Applicant asserts that none of said references describes or otherwise discloses subject matter not already brought to the attention of the Examiner. Rather, Applicant asserts that said references are merely duplicative of information already presented to and/or considered by the Examiner prior to issuance of the February 27, 2007 Office Action. Furthermore, Applicant wishes to point out that the only dates appearing on several of the reexamination-related references have been written in by hand and, therefore, cannot be relied upon. Similarly, no date, page number, or other identifying information appears anywhere on the Otto Bock advertisement presented in the EP Opposition proceeding. The remainder of the listed references either do not qualify as prior art or do not teach or suggest the subject matter claimed by the present application.

CONCLUSION

Applicant has identified support in the specification for the subject matter of the claims rejected by the Examiner under 35 U.S.C § 112. Applicant has also identified additional information that the Examiner may consider of interest to the subject matter of the present application. However, as Applicant believes that said additional information is duplicative of information already considered by the Examiner and/or does not teach or suggest the present invention, Applicant respectfully submits that all pending claims of the present application are now in

condition for allowance, and such action is earnestly requested. Telephone inquiry to the undersigned in order to clarify or otherwise expedite prosecution of the present application is respectfully encouraged.

Respectfully submitted,

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